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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731
20277	7590	07/12/2006	EXAMINER	
MCDERMOTT WILL & EMERY LLP			HAN, QI	
600 13TH STREET, N.W.			ART UNIT	
WASHINGTON, DC 20005-3096			PAPER NUMBER	
			2626	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/593,060		EGUCHI ET AL.	
	Examiner		Art Unit	
	Qi Han		2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

3. This communication is responsive to the applicant's amendment filed 03/27/2006 and RCE examination filed on 05/01/2006. The Applicant(s) amended claims 1, 3-4, 6, 11, 13-14, 16 and 17, and cancelled claims 2 and 15 (see the amendment: pages 2-8).

Response to Arguments

4. Applicant's arguments filed on 03/27/2006 with respect to claim rejection under 35 USC 103 (a), have been fully considered, but are moot in view of the new ground(s) of rejection. The response to the arguments is directed to the corresponding claim rejection (see detail below).

Claim Objections

5. Claim 3 is objected to because of the following informalities:

Regarding claim 3, the claim appears to depend on claim 1 because claim 2 has been cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 3-6, 10-11 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, according to the applicant's clarification in the amendment filed on 03/27/2006, that "the recitation "the language of each language group **consisting of** one of the plurality of languages" is correct and what was intended" (the amendment: page 8, paragraph 2), the limitation of "the language of each language group of printed documents **consisting of** one of the plurality of languages" introduces new subject matter, because the limitation is not specifically described in the original specification.

Regarding claims 3-5, the rejection is based on the same reason described for claim 1, because the dependent claims inherit all limitations of their parent claim(s).

Regarding claims 6 and 10, since the amended claim 6 clearly points out that “the document data of the document (referring to “**a document**”) includes a plurality of different languages”, the claim 10 (depending on claim 6) that inherits the limitation of claim 6 and further recites the limitation “wherein, in a case where a plurality of languages to be translated are specified by said operation unit, said controller controls said translating means so as to translate each original language into the plurality of languages to be translated, and controls said output unit so as to output the plurality of translated languages by groups, the translated language of each group being different from one another”, **as whole**, introduces new subject matter. It is noted that the original specification does not specifically describe how to specify document data of **a document** including a plurality of different languages to be translated into a plurality of languages and outputted by language groups, as claimed.

Regarding claim 11, the new added limitation “each in different language” causes the similar problem as described for claims 6 and 10, so that the rejection is based on the same reason described above.

Regarding claims 17-18, the amended claim 17 and claim 18 has similar problem as described for claims 6 and 10, so that the rejection is based on the same reason described above.

7. Claims 1 and 3-6, 10-11 and 17-18 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Regarding **claim 1**, the amended limitation of “the language of each language group of printed documents consisting of one of the plurality of languages” fails to satisfy the enablement requirement under 35 U.S.C. 112 1st. Since the applicant clarified, in the amendment filed on 03/27/2006, that “the recitation “the language of each language group *consisting of* one of the plurality of languages” is correct and what was intended” (the amendment: page 8, paragraph 2), the claimed limitation is clearly defined as a closed-end claim or Markush claim, either of which requires limited and specific elements in the group (see MPEP 21113.03 and 601.01(P)).

However, the antecedent limitation of the group elements is referred to “a plurality of languages”, which lacks to define the number of elements and each specific element in the group. In another word, applicant fails to specifically point out individual element in the close-end limitation, so that examiner does not know how many elements in the group and what each element really is. Therefore, the claimed limitation was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention, without undue experimentation.

Regarding claims 3-5, the rejection is based on the same reason described for claim 1, because the dependent claims inherit all limitations with the enablement problem included in claim 1.

Regarding claims 6 and 10, since the amended claim 6 clearly points out that “the document data of the document (referring “a document”) includes a plurality of different languages”, the claim 10 (depending on claim 6) inherits the limitation of claim 6 and further recites that “wherein, in a case where a plurality of languages to be translated are specified by said operation unit, said controller controls said translating means so as to translate each original

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language into the plurality of languages to be translated, and controls said output unit so as to output the plurality of translated languages by groups, the translated language of each group being different from one another”, which, as whole, has enablement problem. It is noted that the original specification does not specifically describe how to specify document data of a **document** including a plurality of different languages to be translated and outputted into a plurality of languages by language groups, as claimed (see the closet disclosure in Fig. 2-5 and 12-16), therefore, the claimed limitation was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention, without undue experimentation.

Regarding claim 11, it is similar to claim 10, so that the rejection is based on the same reason described for claim 10 (see above).

Regarding claims 17-18, since they are similar to claims 6 and 10, the rejection is based on the same reason described for claims 6 and 10 (see above).

Claim Rejections - 35 USC § 103

8. Claims 6-9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in view of Fujita (5,612,872).

As per **claim 6**, Yamauchi teaches a translating apparatus comprising:

“translating means for translating document data of a document into another language” (Fig.1 and col. 7, lines 41-54, ‘translation unit 9’);

“an output means for outputting the translated document data translated by said translating means” (col. 4, line 36 to col. 5, line 11, ‘output means for outputting said received document (including translated document data); Fig. 1, ‘bitmap exp 10’ and ‘plotter 11’, ‘PC/WS

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12'; col. 7, lines 54-55, 'the translating unit 9 supplies the output text data...for transfer to the personal computer 12');

"a mode setting unit for setting the translating apparatus in a first mode or a second mode" (col. 4, lines 36-60, 'wherein one of said first and second output means is selectively activated (mode setting)');

"a controller", (col.,7, lines 55-56, 'the system of Fig. 1 includes a system controller', which necessarily controls each unit, such as 'OCR', 'translation' and 'outputs text data representing the result of translation');

"wherein, in a case where the prescribed mode is set [and the document data of the document includes a plurality of the different language,] said controller controls said translating means so as to translate the document data into at least one language, and controls said output unit so as to output the translated document data", (col. 4, lines 39-45, 'translating a received document, written in a first language, to a second, different language...output...in said second language... wherein one of said first and second output means is selectively activated (setting mode)'; col.,7, line 48, 'outputs text data representing the result of translation');

But, Yamauchi does not expressly teach "the document data of the document includes a plurality of different languages". However, this feature is well known in the art as evidenced by Fujita who discloses machine translation system (title) using a translation dictionary for storing related words of a same meaning in at least three languages including source language and the target language (abstract), comprising the translation "when there are a number of different languages mixed in the same text (document)" (Fujita: Fig. 18 and col. 9, lines 56-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

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to modify Yamauchi by providing translation with a number of different languages mixed in the same text (document), as taught by Fujita, for the purpose (motivation) of effectively assisting the checking process for translation between many languages (col. 1, lines 10-11).

As per **claim 7** (depending on claim 6), Yamauchi further teaches “said output unit includes a printing device for printing the translated document data in a sheet” (Fig. 1, ‘plotter 11’).

As per **claim 8** (depending on claim 6), Yamauchi teaches “said output unit includes a display for displaying the translated document data” (Yamauchi: Figs. 2 and col. 8, lines 33-34, ‘display unit 33’).

As per **claim 9** (depending on claim 6), Yamauchi in view of Fujita teaches “an operation unit for specifying a plurality of original languages and at least one language to be translated” (Yamauchi: Figs. 2 col. 7, lines 62, ‘system controller’, ‘input device 32 used by an operator’; Fujita: Figs 14-18 and col. 9, lines 5-40, ‘allow for the selection of one of source language display, specified language display, and language family display...by giving language code’; col. when there are a number of different languages mixed in the same text (document)’; col. 9, lines 56-58, ‘even when there are a number of different languages mixed in the same text (document); which necessary includes specifying the related languages for the translation).

As per **claim 17**, as best understood in view of rejection under 35 USC 112 1st (see above), the rejection is based on the same reason described for claim 6, because the claim recites the same or similar limitations as claim 6.

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9. Claims 1, 4-5, 10-14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view of Fujita and Flores et al. (6,370,498 B1) hereinafter referenced as Flores.

As per **claim 10** (depending on claim 9), as best understood in view of rejection under 35 USC 112 1st (see above), Yamauchi in view of Fujita does not explicitly teach “controls said translating means so as to translate each original language into the plurality of languages to be translated, and controls said output unit so as to output the plurality of translated languages by group, the translated language of each group being different from one another”. However, this feature is well known in the art as evidenced by Flores who discloses apparatus and methods for multilingual user access (title), comprising that ‘the database stores translation of documents in multiple languages and a variety of formats’, ‘user can choose to have the multiple translations’ and ‘to have a work displayed (output) in a written text in two or more separate languages’ (Figs. 3-4 and col. 3, line 64 to col. 4, line 8, and col. 5, lines 27-57), viewing and choosing two or more languages presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B), which suggests the system has capability of outputting multiple languages in different combinations, including groups, such as different formats (contents) in one of languages (by language groups), or one of formats in different languages (by groups or common groups). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamauchi in view of Fujita by providing translating document data in multiple languages and outputting (displaying or printing) the data in different languages, as taught by Flores, for the purpose of being beneficial to users presenting and displaying a written text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

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As per **claim 11**, as best understood in view of rejection under 35 USC 112 1st (see above), the rejection is based on the same reason described for claims 6 and 10, because the claim recites the same or similar limitations as claims 6 and 10.

As per **claims 12-13** (depending on claim 11), the rejection is based on the same reason described for claims 7-8 respectively, because the claims recite the same or similar limitations as claims 7-8 respectively.

As per **claim 14**, the rejection is based on the same reason described for claim 11, because the rejection for claim 11 covers the same or similar limitations as claim 14.

As per **claim 16** (depending on claim 14), the rejection is based on the same reason described for claim 8, because the claim recites the same or similar limitations as claim 8.

As per **claim 18** (depending on claim 17), as best understood in view of rejection under 35 USC 112 1st (see above), the rejection is based on the same reason described for claim 10, because the rejection for claim 10 covers the same or similar limitations as claim 18.

As per **claim 1**, as best understood in view of rejection under 35 USC 112 1st (see above), the rejection is based on the same reason described for claims 6 and 10, because the rejection for claims 6-10 covers the same or similar limitations as claim 1.

As per **claims 4-5** (depending on claim 1), the rejection is based on the same reason described for claims 8-9 respectively, because the claims recite the same or similar limitations as claims 8-9 respectively.

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10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view of Fujita and Flores, and further in view of Miyahara et al. (6,314,213 B1) hereinafter referenced as Miyahara.

As per **claim 3** (depending on claim 1), Yamauchi in view of Fujita and Flores does not explicitly teach "said output includes a sorter for sorting printed sheets by the group". However, this feature is well known in the art as evidenced by Miyahara who teaches using 'a sorter 22' for discharging 'paper sheet' (Fig.2) (col. 7, lines 28-29) and 'a soft key which is used to sort, staple/sort') (col. 8, line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamauchi in view of Fujita and Flores with Miyahara by providing a sorter and related sorting functionality, as taught by Miyahara, for the purpose of implementing user preferred function, like sorting the resultant sheets (Miyahara: col. 8, lines 4-13).

Conclusion

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and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh
June 30, 2006


RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER